

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE**

10X GENOMICS, INC.,

Plaintiff,

v.

CELSEE, INC.,

Defendant.

C.A. No. 19-862-CFC-SRF

**STIPULATION OF DISMISSAL  
OF CLAIMS REGARDING THE '648 PATENT**

WHEREAS, Plaintiff 10x Genomics, Inc. ("10x") has filed suit against Defendant Celsee, Inc. ("Celsee"), asserting among other things a claim for infringement of United States Patent No. 10,227,648 ("the '648 Patent");

WHEREAS, Celsee has filed counterclaims against 10x for declaratory judgment of non-infringement of the '648 Patent, declaratory judgment of invalidity of the '648 Patent, and declaratory judgment of unenforceability as to the '648 Patent;

WHEREAS, on March 4, 2019, 10x provided Celsee an unconditional and irrevocable covenant not to sue for infringement of the '648 Patent based on Celsee's sales, use, and manufacture of the Genesis Platform (Exhibit A);

WHEREAS, the parties have agreed for 10x to dismiss its claim against Celsee for infringement of the '648 Patent and for Celsee to dismiss its counterclaims for declaratory judgment of non-infringement of the '648 Patent and declaratory judgment of invalidity of the '648 Patent, as well as its counterclaim for declaratory judgment of unenforceability as concerns the '648 Patent;

NOW, THEREFORE, IT IS HEREBY STIPULATED by and between the parties, subject to the approval of the Court, as follows:

1. Pursuant to Federal Rule of Civil Procedure 41, 10x hereby dismisses, with prejudice, its claim against Celsee for infringement of the '648 Patent.

2. Pursuant to Federal Rule of Civil Procedure 41, Celsee hereby dismisses, without prejudice, its counterclaims against 10x for declaratory judgment of non-infringement of the '648 Patent and declaratory judgment of invalidity of the '648 Patent, as well as its counterclaim for declaratory judgment of unenforceability as concerns the '648 Patent.

/s/ Frederick L. Cottrell, III

Frederick L. Cottrell, III (#2555)  
Jason J. Rawnsley (#5379)  
Alexandra M. Ewing (#6407)  
RICHARDS, LAYTON & FINGER, P.A.  
920 N. King Street  
Wilmington, DE 19801  
(302) 651-7550  
cottrell@rlf.com  
rawnsley@rlf.com  
ewing@rlf.com

*Attorneys for Plaintiff 10X Genomics, Inc.*

Dated: March 10, 2020

/s/ Brian E. Farnan

Brian E. Farnan (#4089)  
Michael J. Farnan (#5165)  
919 N. Market Str., 12th Floor  
FARNAN LLP  
Wilmington, DE 19801  
(302) 777-0300  
bfarnan@farnanlaw.com  
mfarnan@farnanlaw.com

*Attorneys for Defendant Celsee, Inc.*

IT IS SO ORDERED this 11<sup>th</sup> day of March, 2020.

  
UNITED STATES DISTRICT JUDGE

# **Exhibit A**

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE**

10x GENOMICS, INC.,

Plaintiff,

v.

CELSEE, INC.,

Defendant.

C.A. No. 19-00862-CFC-SRF

---

**10X GENOMICS, INC.'S COVENANT RE UNITED STATES PATENT NO.  
10,227,648**

WHEREAS 10x Genomics, Inc. (“10x”) and Celsee, Inc. (“Celsee”) are parties in the above-captioned litigation, in which 10x has asserted infringement of certain claims of United States Patent No. 10,227,648 (“the ’648 Patent”) by Celsee, based on its making, importing, using, testing, demonstrating, selling, and offering for sale the Genesis Platform (including the Genesis System and its associated accessories and reagents), and Celsee has challenged the validity of claims of the ’648 Patent,

NOW, THEREFORE, in light of the foregoing, and in an effort to streamline and simplify the issues for resolution in this case, 10x, on behalf of itself and any successors-in-interest to its rights under the ’648 Patent, hereby unconditionally and irrevocably covenants not to assert that Celsee’s activities related to the Genesis Platform, or Celsee products that are not more than insubstantially different from the Genesis Platform, whether occurring before or after the date of this covenant, infringe (including direct infringement, contributory infringement, and induced infringement) any claim of the ’648 Patent as it currently reads. This covenant extends to claims of infringement of the ’648 Patent against Celsee’s past, current, and future suppliers, distributors, customers, licensees, and end users based on their use of the Genesis Platform or Celsee products that are not more than insubstantially different from the Genesis Platform.

This covenant covers all claims of the ’648 Patent as they currently read, and

any claim in any reissued, reviewed, or reexamined version of the '648 Patent that is the same as, or substantially identical to, any claim of the '648 Patent as it currently reads. The term "substantially identical" as used herein is intended to have the same meaning as that term is used in 35 U.S.C. § 252.

This covenant does not extend to: (1) any claim in any reissued or reexamined version of the '648 Patent that is not the same as, or substantially identical to, any claim of the '648 Patent as it currently reads; (2) any claim in any other patent that is or may be issued by the United States Patent Office or foreign patent agency, whether related or unrelated to the '648 Patent; or (3) any activities related to any products other than the Genesis Platform, except for products manufactured, distributed, or sold by Celsee that are not more than insubstantially different from the Genesis Platform.

OF COUNSEL:

Daralyn J. Durie  
Eugene Novikov  
Andrew Perito  
Eneda Hoxda  
Henry H. Cornillie  
DURIE TANGRI LLP  
217 Leidesdorff Street  
San Francisco, CA 94111  
Telephone: 415-362-6666  
Facsimile: 415-236-6300  
ddurie@durietangri.com  
enovikov@durietangri.com  
aperito@durietangri.com  
ehoxda@durietangri.com  
hcornillie@durietangri.com

Dated: March 4, 2020

/s/ Jason J. Rawnsley

Frederick L. Cottrell, III (#2555)  
Jason J. Rawnsley (#5379)  
Alexandra M. Ewing (#6407)  
RICHARDS, LAYTON & FINGER,  
P.A.  
One Rodney Square  
920 North King Street  
Wilmington, DE 19801  
(302) 651-7700  
cottrell@rlf.com  
rawnsley@rlf.com  
ewing@rlf.com

*Attorneys for Plaintiff 10x Genomics,  
Inc.*



**CERTIFICATE OF SERVICE**

I hereby certify that on March 4, 2020, I caused true and correct copies of the foregoing document to be served on the following counsel in the manner indicated:

**VIA EMAIL**

Brian E. Farnan  
Michael Farnan  
FARNAN LLP  
919 N. Market St., 12th Floor  
Wilmington, DE 19801  
(302) 777-0300  
bfarnan@farnanlaw.com  
mfarnan@farnanlaw.com

**VIA EMAIL**

Barbara A. Fiacco  
Jeremy A. Younkin  
Brendan Jones  
Emma S. Winer  
Urszula Nowak  
FOLEY HOAG LLP  
Seaport West  
155 Seaport Boulevard  
Boston, MA 02210  
(617) 832-1000  
bfiacco@foleyhoag.com  
jyounkin@foleyhoag.com  
bjones@foleyhoag.com  
ewiner@foleyhoag.com  
unowak@foleyhoag.com

/s/ Jason J. Rawnsley

Jason J. Rawnsley (#5379)  
rawnsley@rlf.com